

REMARKS

Initially, Applicants would like to express appreciation to the Examiner for the detailed Official Action provided.

Upon entry of the above amendment, claims 20, 25, 30, and 32 will have been amended. Accordingly, claims 15-34 are currently pending. Applicants respectfully request reconsideration of the outstanding rejections and allowance of claims 15-34 in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

The Examiner has rejected claims 20, 25, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully submit that in view of the herein contained amendments and remarks, the basis for such rejection is no longer appropriate and Applicants thus respectfully request reconsideration and withdrawal of the rejection of claims 20, 25, and 30 under 35 U.S.C. § 112, second paragraph.

The Examiner has rejected claims 20 and 30 under 35 U.S.C. § 112, second paragraph, as lacking proper antecedent basis for “after the driving of the inner blade is resumed” in lines 2 and 3. In response thereto, Applicants have amended claim 20 to depend from claim 19 and to recite “wherein at least one of the driving frequency and the driving amplitude of the inner blade after the driving of the inner blade is resumed at the end of the second duration is set smaller than the corresponding driving frequency or driving amplitude before the driving of the inner blade is suspended for a second duration while the electric razor is operated in the cleaning drive mode”. Applicants have

amended claim 30 to depend from claim 29 and to recite “wherein the number of the driving revolutions per unit time of the inner blade after the driving of the inner blade is resumed at the end of the second duration is set smaller than the corresponding number of driving revolutions per unit time before the driving of the inner blade is suspended for a second duration while the electric razor is operated in the cleaning drive mode”.

The Examiner has rejected claim 25 under 35 U.S.C. § 112, second paragraph, as the phrase “to drive the inner blade at a predetermined number of driving revolutions” is unclear. In response thereto, Applicants have amended claim 25 to recite “number of driving revolutions per unit time”. Claim 32, which depends from claim 25, has also been amended to recite “number of driving revolutions per unit time”.

Accordingly, in view of the above noted amendments and remarks, all of the claims are believed to fully comply with 35 U.S.C. § 112, second paragraph, and Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under 35 U.S.C. § 112, second paragraph.

Claims 15-34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over VAN DER BORST (U.S. Patent No. 5,671,535) in view of DEKKER (EP 0 652 087).

However, Applicants note that VAN DER BORST and DEKKER fail to teach or suggest the subject matter claimed in claims 15 and 25. In particular, claim 15 sets forth, inter alia, an electric razor including, inter alia, an inner blade, an outer blade, a driving portion, “a controller that controls the driving portion so as to drive the inner blade at a predetermined driving frequency and a predetermined driving amplitude”, a main switch, and a mode switch, wherein the controller controls the driving portion, and “at least one

of the driving frequency and the driving amplitude of the inner blade in the cleaning drive mode is set smaller than the corresponding driving frequency or driving amplitude in the normal drive mode, and a maximum instantaneous moving speed of the driving inner blade is set at 60 m or lower per minute, and a moving speed of the driving inner blade is instantaneously set at 20 m or higher per minute in the cleaning drive mode”. Claim 25 sets forth an electric razor including, inter alia, an inner blade, an outer blade, a driving portion, “a controller that controls the driving portion so as to drive the inner blade at a predetermined number of driving revolutions per unit time”, a main switch, and a mode switch, wherein the controller controls the driving portion, and “the number of driving revolutions per unit time in the cleaning drive mode is set smaller than the corresponding number of driving revolutions per unit time in the normal drive mode, and a maximum instantaneous moving speed of the driving inner blade is set at 60 m or lower per minute, and a moving speed of the driving inner blade is instantaneously set at 20 m or higher per minute in the cleaning drive mode”.

Applicant’s claimed electric razor includes a driving unit 7 that is electrically connected to the inner blade 3, and that reciprocates the inner blade 3. The driving unit 7 includes a linear motor, or a rotary motor, and a cam. The driving unit 7 is configured to operate such that a driving frequency (the number of reciprocations of the inner blade 3 per unit time) is variable depending on the control signal that is outputted from the controller 13; and a driving amplitude (a moving distance of the inner blade 3 in one reciprocation) is set at a constant. With this arrangement, the moving speed of the inner blade 3 is proportional to the driving frequency. Further, the controller 13 controls the device so that the moving speed of the inner blade 3 is controlled by controlling the

driving frequency of the driving unit 7 based on the control signal. The driving unit 7 may be configured so that the driving amplitude is variable, while the driving frequency is constant; the driving unit 7 may be configured so that the driving frequency is variable while the driving amplitude is constant. Additionally, the driving unit 7 may be configured so that the driving unit 7 controls the moving speed of the inner blade 3 by controlling both the driving amplitude and the driving frequency.

Further, Applicants' claimed electric razor may include a rotary electric razor in which the inner blade is rotatable. In this embodiment, the driving unit 7 may be configured so that the number of revolutions per unit time of the inner blade 3 is variable; and the controller 13 may control the moving speed of the inner blade 3 by controlling the number of revolutions of the driving unit 7 based on the control signal. See particularly pages 5-6 of Applicants' specification.

Accordingly, the present invention comprises an electric razor having advantages over the prior art. Advantages include at least an electric razor that efficiently cleans the blade without using any additional cleaning appliances; and that avoids the unwanted scattering of water and shaving debris.

The VAN DER BORST patent discloses a shaver including a controller for controlling the motor speed. The VAN DER BORST et al. patent discloses that the shaver may operate with different motor speeds for the user's desired combination of shaving performance, shaving comfort, and power consumption.

The Examiner has taken the position that VAN DER BORST includes a controller "so as to drive the inner blade at a predetermined driving frequency and a predetermined driving amplitude (inherent properties of the razor, see figure 3, and figure 4a-c and 11a-

c), or a predetermined number of driving revolutions (if a user selects the number of seconds the razor is to be on, then there is inherently a predetermined number of revolutions)”).

However, contrary to the Examiner’s assertions, VAN DER BORST et al. does not disclose any particular driving frequency, driving amplitude, or number of revolutions per unit time. Moreover, the VAN DER BORST et al. patent fails to disclose a controller that *controls* one of driving frequency, driving amplitude, or number of revolutions per unit time. Nonetheless, the Examiner takes the position that a controller that controls the driving frequency, driving amplitude, and number of revolutions per unit time is inherent in the shaver of VAN DER BORST.

However, while the inherent disclosure of a prior art reference may be relied upon in a rejection, the Examiner must provide some rationale or evidence tending to show inherency. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Further, to establish inherency, the Examiner must provide evidence that makes it clear that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill (emphasis added). *In re Robertson*, 169 F.3d 743,745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). To properly rely on a theory of inherency, there must be provided “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*,

17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). See Manual of Patent Examining Procedure (MPEP) § 2112.

In the present case, the Examiner has not presented any evidence at all that the VAN DER BORST device *necessarily* must include a controller that controls driving frequency, driving amplitude, and number of revolutions per unit time. In fact, as described above, it does not even appear that the VAN DER BORST device *may* include a controller that *controls* driving frequency, driving amplitude, and number of revolutions per unit time. Accordingly, contrary to the Examiner's position, a controller that controls driving frequency, driving amplitude, and number of revolutions per unit time is not inherent in the shaver of the VAN DER BORST patent. Therefore, even assuming, arguendo, that the modification asserted by the Examiner were made, Applicants' claimed electric razor would not result; and the rejection of claims 15 and 25 under 35 U.S.C. § 103(a) over VAN DER BORST in view of DEKKER is improper for all the above reasons and withdrawal thereof is respectfully requested.

Additionally, the DEKKER patent also fails to teach or suggest a shaver including a controller that controls driving frequency, driving amplitude, and number of revolutions per unit time. Therefore, the DEKKER patent fails to cure the deficiencies of the VAN DER BORST device, and even assuming, arguendo, that the teachings of VAN DER BORST and DEKKER have been properly combined, Applicants' claimed electric razor would not have resulted from the combined teachings thereof; and the rejection of claims 15 and 25 under 35 U.S.C. § 103(a) over VAN DER BORST in view of DEKKER is improper for all the above reasons and withdrawal thereof is respectfully requested.

Additionally, as recognized by the Examiner, the VAN DER BORST patent fails to teach or suggest a blade speed between 20 and 60 meters per minute. The Examiner takes the position that it would have been obvious to one having ordinary skill in the art to select a range of appropriate speeds for the blades to operate within, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

However, Applicants submit that nothing in the prior art teaches or suggests the claimed combination including the claimed blade speed. Accordingly, Applicants submit that a factual basis for the rejection has not been established and thus a prima facie case of obviousness has not been established, and that rejection of claims 15 and 25 under 35 U.S.C. § 103(a) can only result from a review of Applicants' disclosure and the application of impermissible hindsight. Accordingly, the rejection of claims 15 and 25 under 35 U.S.C. § 103(a) over VAN DER BORST et al. in view of DEKKER is improper for all the above reasons and withdrawal thereof is respectfully requested.

The Examiner takes the position that, alternatively, it would have been obvious to modify the VAN DER BORST device by limiting the blade speed to between 24 and 72 meters per minute as taught by DEKKER to improve shaving performance.

However, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 15 and 25 under 35 U.S.C. § 103(a) over VAN DER BORST in view of DEKKER. Thus, the only reason to combine the teachings of VAN DER BORST and DEKKER results from a review of Applicants' disclosure and the application of impermissible hindsight. Accordingly, the rejection of claims 15 and 25 under 35 U.S.C.

§ 103(a) over VAN DER BORST in view of DEKKER is improper for all the above reasons and withdrawal thereof is respectfully requested.

Accordingly, the rejection of claims 15 and 25 under 35 U.S.C. § 103(a) over VAN DER BORST et al. in view of DEKKER is improper for at least all of the above reasons and withdrawal thereof is respectfully requested.

Applicants submit that dependent claims 16-24 and 26-34, which are at least patentable due to their dependency from claims 15 and 25 for the reasons noted above, recite additional features of the invention and are also separately patentable over the prior art of record based on the additionally recited features.

Claims 24 and 34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over VAN DER BORST in view of DEKKER, and further in view of MOMOSE (U.S. Patent No. 5,920,988).

Applicants note that VAN DER BORST and DEKKER fail to teach or suggest the subject matter claimed, including, inter alia, an inner blade, an outer blade, a driving portion, “a controller that controls the driving portion so as to drive the inner blade at a predetermined driving frequency and a predetermined driving amplitude”, a main switch, and a mode switch, wherein the controller controls the driving portion, and “at least one of the driving frequency and the driving amplitude of the inner blade in the cleaning drive mode is set smaller than the corresponding driving frequency or driving amplitude in the normal drive mode, and a maximum instantaneous moving speed of the driving inner blade is set at 60 m or lower per minute, and a moving speed of the driving inner blade is instantaneously set at 20 m or higher per minute in the cleaning drive mode”, as set forth in independent claim 15, as discussed above. Further, VAN DER BORST and DEKKER



fail to teach or suggest the subject matter claimed, including, inter alia, an inner blade, an outer blade, a driving portion, “a controller that controls the driving portion so as to drive the inner blade at a predetermined number of driving revolutions per unit time”, a main switch, and a mode switch, wherein the controller controls the driving portion, and “the number of driving revolutions per unit time in the cleaning drive mode is set smaller than the corresponding number of driving revolutions per unit time in the normal drive mode, and a maximum instantaneous moving speed of the driving inner blade is set at 60 m or lower per minute, and a moving speed of the driving inner blade is instantaneously set at 20 m or higher per minute in the cleaning drive mode”, as set forth in independent claim 25, as discussed above.

Further, MOMOSE fails to cure these deficiencies. Moreover, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 24 and 34 under 35 U.S.C. § 103(a) over VAN DER BORST in view of DEKKER, and further in view of MOMOSE. Thus, the only reason to combine the teachings of VAN DER BORST, DEKKER, and MOMOSE results from a review of Applicants' disclosure and the application of impermissible hindsight. Even if the teachings of VAN DER BORST, DEKKER, and MOMOSE were combined, as suggested by the Examiner, the claimed combination would not result. Accordingly, the rejection of claims 24 and 34 under 35 U.S.C. § 103(a) over VAN DER BORST in view of DEKKER, and further in view of MOMOSE is improper for all the above reasons and withdrawal thereof is respectfully requested.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections, and an early indication of the allowance of claims 15-34.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is proper and that none of the references of record, considered alone or in any proper combination thereof, anticipate or render obvious Applicants' invention as recited in claims 15-34. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action, and allowance of the present amendment and all of the claims therein are respectfully requested and now believed to be appropriate.

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

Any amendments to the claims which have been made in this amendment, which do not narrow the scope of the claims, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered cosmetic in nature, and to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,  
Yasuo IBUKI et al.

A handwritten signature in black ink, appearing to read "Linda J. Hodge". The signature is fluid and cursive, with the first name "Linda" being the most prominent.

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